

REMARKS

The present invention relates to a method for filling the gap between two lengths of coated pipe in which a polyurethane-forming composition is employed.

Claims 1-11 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The specific basis for this rejection is that there is no basis for the weight percentage values recited in Claim 1.

Applicant believes that the amendments made to Claim 1 to recite the basis for the given percentages remove the basis for this rejection.

Withdrawal of this rejection is therefore requested.

Claims 1-11, 13-29 and 31-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hagquist (U.S. 6,288,133) in view of McBrien et al (U.S. 5,328,648) and Isobe et al (U.S. 6,433,033). Applicant respectfully traverses this rejection.

Hagquist discloses a foamable composition made up of at least two parts. The first part includes at least one polyol, at least one gelling agent and at least one blowing agent. The second part includes at least one isocyanate.

Hagquist does not teach or suggest a method for filling a gap at the junction between two lengths of coated pipe.

The teachings of Hagquist can not therefore be construed in any manner which would teach or suggest Applicant's method for filling a gap at the junction between two lengths of coated pipes claimed in Claims 13 -29 and 31-32.

The Hagquist compositions are distinguishable from the compositions of the present invention as claimed in Claims 1-11 in several respects. Specifically, Hagquist does not teach or suggest: (1) the amounts of TXIB required in Applicant's claimed invention; (2) Hagquist does not teach or suggest that the disclosed compositions or any particular modification thereof would withstand the stresses encountered in curing a polyurethane to fill the gap between two concrete-coated pipes as taught by McBrien et al; and (3) Hagquist requires castor oil-derived polyols and not an amine-based polyether polyol of the type required in Applicant's claimed invention.

With respect to the first distinction enumerated above, Hagquist teaches that a plasticizer is preferably used in the disclosed compositions. If used, such plasticizer may be used in an amount of from about 1 to about 25 wt.% in the isocyanate component and/or the isocyanate-reactive component. TXIB is taught to be the preferred plasticizer.

In contrast, Applicant's claimed compositions require from 50 to 65 wt.% TXIB in the B-side component plus from 15 to 25 wt.% TXIB in the A-side component.

Further, one skilled in the art would not be motivated by any teaching of Hagquist to use more than 25 wt.% TXIB in the B-side component because Hagquist illustrates in the Examples presented therein that amounts of TXIB of from 5.25 to 20 parts produce foams having the properties sought by Hagquist.

With respect to the second distinction enumerated above, there is no teaching in Hagquist with respect to the ability of the disclosed compositions to withstand the stresses encountered in curing to which a gap-filling composition is subjected that are discussed in the cited McBrien et al reference. One skilled in the art seeking to develop an improved gap-filling composition would not therefore be taught how to achieve his desired goal by Hagquist.

With respect to the third distinction enumerated above, Hagquist teaches that use of a castor oil based polyol is critical to the disclosed compositions and that other known polyols may optionally be included. One skilled in the art reading Hagquist would therefore need to ignore the reference teaching with respect to its critical polyol and select amine based polyether polyols from the many known polyols taught to be suitable in order to "arrive at" the polyol required in Applicant's invention.

McBrien et al has been cited for its teaching of a method of using a composite joint infill system.

It is the Patent Office position that it would have been obvious to one skilled in the art to use the Hagquist composition in the method disclosed by McBrien et al.

Applicant respectfully disagrees.

McBrien et al clearly teaches at column 5, line 66 through column 6, line 7 that all plasticizers are not equivalent in composite joint infill systems.

One skilled in the art reading the McBrien et al reference could not therefore expect with any reasonable degree of certainty that use of TXIB would result in a composition with a reduced tendency to crack during cure. Nor would the McBrien et al reference suggest to that skilled artisan that use of TXIB in amounts greater than those taught by Hagquist would be beneficial for any reason.

Combination of the teachings of McBrien with those of Hagquist does not therefore render Applicant's invention as claimed in Claims 1-11 obvious.

Further, McBrien et al does not teach or suggest that an ester-containing polyurethane/urea composition would be suitable for use in the disclosed method for filling the gap between two coated pipes. Hagquist does not teach or suggest anything with respect to a method for filling the gap between two coated pipes. The teachings of these references can not therefore be properly combined in any manner which would render obvious Applicant's invention as claimed in Claims 13-29 and 31-32.

Isobe et al was cited for its teaching of amine-initiated polyether polyols.

Applicant maintains that Isobe et al's teaching of a large number of polyether polyols among which are amine-initiated polyether polyols does not supply any of the teachings missing from the Hagquist and McBrien et al references necessary to support a proper rejection of the claimed invention under 35 U.S.C. §103.

More specifically, Isobe et al does not teach anything with respect to joint infilling compositions or processes. Isobe et al does not teach anything which would lead one skilled in the art seeking to develop an improved joint infilling composition or method to select an amine-initiated polyether polyol from the hundreds of polyols disclosed therein for use in a joint infilling composition. Isobe et al does not teach or suggest anything which would lead one skilled in the art to ignore the teachings of Hagquist with respect to the criticality of using a castor oil based polyol and select instead an amine-initiated polyether polyol.

Further, Isobe et al is directed to the production of foams for use in furniture. No correlation between the problems solved by Isobe et al and those solved by Hagquist and by McBrien et al has been established. One skilled in the art seeking to develop an improved joint infilling composition and process would not therefore

consider it obvious to combine the teachings of Hagquist or Isobe et al with the teachings of McBrien.

However, even if one skilled in the art were to attempt to combine the teachings of these references, not one of the cited references teaches the use of TXIB in the amounts required for Applicant's compositions claimed in Claims 1-11. Not one of the cited references teaches or suggests a joint infilling method in which a polyurethane/urea composition containing an ester is employed as is required in Applicant's Claims 13-29 and 31-32.

The combined teachings of Hagquist, McBrien and Isobe et al do not therefore render Applicant's claimed invention obvious.

Withdrawal of this rejection is therefore requested.

Claims 1-11, 13-29 and 31-32 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-13 of U.S. Patent No. 6,521,673 in view of McBrien et al (U.S. Patent 5,328,648).

The present application and U.S. Patent No. 6,521,673 are commonly owned. A terminal disclaimer over U.S. Patent 6,521,673 will be provided upon receipt of an indication that the rejections of the claims pending in this case under 35 U.S.C. §112, second paragraph and under 35 U.S.C. §103(a) have been withdrawn.

It is believed that the filing of this terminal disclaimer will remove U.S. Patent 6,521,673 as the basis for this rejection and thereby overcome this rejection.

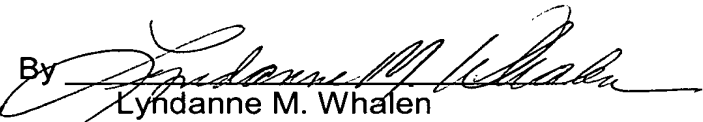
Claims 1-11, 13-29, 31 and 32 have also been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-6, 8-45, 47 and 48 of co-pending Application No. 10/326,338 in view of McBrien et al (U.S. Patent 5,328,648).

The present application and U.S. Patent Application No. 10/326,338 are commonly owned. A terminal disclaimer over U.S. Patent Application No. 10/326,338 will be provided upon receipt of an indication that the rejections of the claims pending in this case under 35 U.S.C. §112, second paragraph and under 35 U.S.C. §103(a) have been withdrawn.

It is believed that the filing of this terminal disclaimer will remove U.S. Patent Application No. 10/326,338 as the basis for this rejection and thereby overcome this rejection.

In view of the above amendments and remarks, reconsideration and withdrawal of the rejections of Claims 1-11, 13-29 and 31-32 are respectfully requested.

Respectfully submitted,

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